

## REMARKS

### **35 U.S.C. § 112**

Claims 8 and 33 are rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite.

Applicant respectfully traverses the rejection of claims 8 and 33 under 35 U.S.C. § 112. Claim 8 recites that weightings for the *measurement* categories are not input into the computer analysis tool, while claim 1 recites that the weightings for the *evaluation* categories are input into the analysis tool. Measurement categories and evaluation categories are not the same thing. Paragraph [0040] of the Specification gives examples of measurement categories (e.g., Increase AuM), while Paragraph [0025] gives examples of evaluation categories (e.g., profile assessment). Figure 20A, for example, shows the relationship between the measurement categories and the evaluation categories. The weightings (406) shown in Figure 20A are each associated with one of the evaluation categories. According to claim 8, weightings for the measurement categories are not input into the analysis tool. Applicant respectfully submits that the claim features related to inputting weightings for the evaluation categories (claim 1), and *not* inputting weightings for the measurement categories (claim 8), are not inconsistent. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 8 and 33 under 35 U.S.C. § 112, ¶ 2.

### **35 U.S.C. § 103 Claim Rejections**

Claims 1, 8, 17, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown (US 2005/0010469) in view of Grey ("An analytic approach for quantifying the value of e-business initiatives").

Applicant respectfully traverses the rejection of claims 1, 8, 17, and 33. It is respectfully submitted that the prior art of record does not disclose all of the features of Applicants' amended claims. The combination of Brown and Grey discloses a consulting assessment environment, but do not disclose the claimed method for evaluating portfolio management.

Claim 1 recites, among other things, collecting a weighting from an industry expert being interviewed for each of the evaluation categories before asking evaluation questions. Claim 17 includes similar features. In the rejection, the Office Action points to paragraphs [0044] and [0050] of Brown, which mention weight factors generally in a list of several features. The combination of Grey and Brown is silent on what the weight factors are, how the weight factors are generated, and how the weight factors are applied. The general reference to “weight factors” in Brown does not teach or disclose collecting a weighting from an industry expert being interviewed for each of the evaluation categories before asking evaluation questions.

Further, the combination of Brown and Grey does not disclose the claimed value chain or performance attribute analyses of claims 1 and 17. The Office Action relies on the Grey reference to disclose value chain steps and performance attributes and asserts that Grey teaches that the analysis comprises separate analyses for each of the value chain steps and the performance attributes. Claim 1 and 17, however, recites more than just separate analyses for value chain steps and performance attributes.

Claim 1 and 17 recite a value chain analysis that involves comparing an aggregate of the responses to the evaluation questions within each value chain step to the weighting associated with each value chain step. Claims 1 and 17 also recite a performance attribute analysis that involves comparing an aggregate of the responses to the evaluation questions that are interspersed across the groups of questions to the weighting associated with each performance attribute. Claim 1 and 17 further recite that the interspersed evaluation questions are included in both the value chain analyses and the performance attribute analyses. None of these features are addressed in the Office Action or disclosed or taught in the Grey reference, nor in the combination of the Grey reference and Brown.

Claim 8, which depends from claim 1, recites grouping the responses to the evaluation questions into measurement categories. Claim 8 is amended to clarify that the responses are grouped into one of a plurality of measurement categories. Claim 8 further recites that the measurement categories are not weighted. Brown and the Grey reference, whether considered alone or in combination, do not disclose grouping the responses to evaluation questions into measurement categories and combining the

grouped responses into an effectiveness result for each measurement category, as claimed.

The prior art references cited in the Office Action relate generally to the concepts of consulting assessment using value chain steps and performance attributes, but none of the prior art references disclose the specific approach of evaluating portfolio management claimed by Applicant. Applicant's claims presented include limitations that are not found or suggested in the prior art.

Applicant also respectfully notes that there are several features of the claims, as identified above, that do not appear to be addressed in the Office Action. In assessing the patentability of a claim, the Examiner must consider all of the claim limitations. MPEP § 2143.03. It is respectfully submitted that Applicants' claims as presented are not obvious when all of the claim limitations are considered "as a whole." 35 U.S.C. § 103(a).

For the foregoing reasons, Applicant respectfully submits that the combination of Brown and Grey does not disclose all the features of claims 1, 8, 17, and 33, and respectfully requests withdrawal of the § 103(a) rejection and allowance of the claims.

### **Conclusion**

In response to the Examiner's comments, Applicant respectfully traverses the rejections of claims 1, 8, 17, and 33. It is respectfully submitted that none of the prior art of record discloses all of the limitations of Applicant's claims and there is no suggestion or motivation to combine the prior art to achieve Applicant's claimed inventions. Therefore, Applicant's claims are allowable. Accordingly, Applicants request reconsideration and allowance of the application.

Respectfully submitted,

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